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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,137	01/19/2006	Victor Paul Eliu	HC/1-22926/A/PCT	9022
324 7590 01/19/2007 CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			EXAMINER POWERS, FIONA	
			ART UNIT 1626	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/19/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/565,137	Applicant(s) ELIU ET AL.	
	Examiner Fiona T. Powers	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-19 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 7, 11-16, 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 5, 6, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/17/06</u> . | 6) <input type="checkbox"/> Other: ____ |

Art Unit: 1626

Receipt is acknowledged of the preliminary amendment filed January 19, 2006 and the information disclosure statement filed July 17, 2006, which have been entered in the file.

Claim 17 is objected to because of the following informalities: in line 2 of claim 17, the phrase "or strands" should be inserted after "hair" to be consistent with the preamble. Appropriate correction is required.

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 5 is not a further limitation of claim 1 because for each of the dyes listed in claim 5, the group that corresponds to R_3 in claim 1 is hydrogen. However, R_3 in claim 1 cannot be hydrogen. Also, in formula (16) of claim 5, the group that corresponds to R_2 is cyclohexyl but R_2 in claim 1 cannot be cyclohexyl. This objection can be overcome by making claim 5 independent.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

Art Unit: 1626

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuhlthau (US 4294756), cited by applicants.

The reference discloses the claimed dye of the formula (3).
Note Example 33 in column 8, lines 41 to 51.

Claims 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Abdallah et al. (US 4079130) or Kuhlthau (US 4294756), cited by applicants or Japanese Patent 56-053,658, cited.

The references disclose the claimed dye of the formula (21) and the claimed process for its preparation. Note column 3, Table I, Example 3 of Abdallah et al.; Example 33, column 8, lines 17 to 26 of Kuhlthau; and page 2, the first entry in the table at the top of the right-hand column.

Claims 6 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann et al. (US 3216995), cited or Baumann et al. (GB 885046) or Kuhlthau (GB 2029439), cited by applicants.

The references disclose the claimed dye of the formula (18) where R_1 is methyl and R_3 and R_7 are methoxy or halide and the claimed process for its preparation. Note claim 5 of Baumann et al. US 3216995; Example 3 and the third compound listed in the

Art Unit: 1626

table on page 5 of Baumann et al. GB 885046); and Example 1, page 3, lines 18 to 21 of Kuhlthau GB 2029439.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulthau (US 4294756).

Determination of the scope and content of the prior art (MPEP §2141.01)

The reference discloses a homolog of the claimed dye of the formula (17) that is used for the dyeing of polyacrylonitrile. Note Example 33 in column 8, lines 41 to 51.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The dye in column 8, lines 41 to 51 differs from the claimed dye of the formula (17) in that a hydrogen atom replaces the methyl group attached to the amino group.

Finding of prima facie obviousness---rational and motivation (MPEP §2142-2413)

However, it has been held that it is obvious to replace a hydrogen atom with a lower alkyl group and vice versa. See In re Hoeksema, 158 USPQ 598. One of ordinary skill in the art would have been motivated to prepare the homolog of the dye

Art Unit: 1626

disclosed in the reference with the expectation that it would also be useful for the dyeing of polyacrylonitrile. The claimed dye would have been rendered obvious by the homolog of the reference in the absence of any unobvious or unexpected property.

Claim 1 to 4, 7, 11 to 16, 18 and 19 are allowed.

The references made of record and not relied upon show the state of the art.

Claims 1, 2, 4, 7, 11 and 15 are allowable over the prior art of record because R_3 in these claims cannot be hydrogen. However, if applicants amend claim 1 and 7 so that the definition of R_3 includes hydrogen, rejection of claims 1, 2, 4, 7, 11 and 15 over the prior art of record would be appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
January 12, 2007